

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

DAILY NEWS, LP; CHICAGO TRIBUNE
COMPLANY, LLC; ORLANDO
SENTINEL COMMUNICATIONS
COMPANY, LLC; SUN-SENTINEL
COMPANY, LLC; SAN JOSE MERCURY
NEWS, LLC; DP MEDIA NETWORK,
LLC; ORB PUBLISHING, LLC; AND
NORTHWEST PUBLICATIONS, LLC

Plaintiffs,

v.

MICROSOFT CORPORATION, et al.,

Defendants.

Civil Action No. 1:24-cv-3285 (SHS) (OTW)

**PLAINTIFFS' SUBMISSION REGARDING MICROSOFT'S COMPLIANCE
WITH FED. R. CIV. P. 5.1**

Pursuant to this Court's Order dated January 23, 2025, Plaintiffs in the above-referenced action hereby advise this Court as follows with respect to the portion of Microsoft Corporation's ("Microsoft's") motion to dismiss (ECF 77) directed to Plaintiffs' state law trademark dilution claim (Count VIII). ECF 77 at 23-25.

1. This Court is correct that under Federal Rule of Civil Procedure Rule 5.1, Microsoft Corporation was required to file with this Court "a notice of constitutional question, stating the question and identifying the paper that raises it." *See*, Fed. R. Civ. P. Rule 5.1. Additionally, Microsoft was required to serve the notice and the paper on the New York State Attorney General. *Id.*

2. Microsoft has argued that it was not required to file a notice of constitutional question because its challenge to the constitutionality of the New York State dilution statute is (1) an “as applied” challenge rather than a “facial” challenge, and (2) because the question of constitutionality was not raised in a complaint but only a motion. (Tr. at 87.) Plaintiffs are not aware of any caselaw holding that the requirements of Rule 5.1 apply only to “facial” challenges rather than “as applied” challenges. Furthermore, Rule 5.1 does not limit its requirements to complaints alone; the express language of Rule 5.1 refers to any “pleading, written motion, or other paper” that raises a constitutional question. Fed. R. Civ. P. Rule 5.1. Microsoft should therefore be required promptly to file and serve on the Attorney General of the State of New York the required notice of constitutional question.

3. Because Rule 5.1 applies, it appears that a certification under 28 U.S.C. § 2403 from this Court to the New York State Attorney General is also required.

4. However, Plaintiffs submit that once Microsoft files and serves the required notice and this Court provides the certification, this Court need not wait to deny this portion of Microsoft’s motion. Rule 5.1(c) states that “[b]efore the time [for the attorney general] to intervene expires, the court may reject the constitutional challenge...” Fed. R. Civ. P. Rule 5.1(c). Microsoft’s constitutional challenge is, for the reasons set forth in Plaintiffs’ opposition brief (ECF 98) at pages 23-25, without basis and is directly inconsistent with the Supreme Court’s recent ruling in *Nat’l Pork Producers Council v. Ross*, 598 U.S. 356 (2023). Furthermore, Plaintiffs submit that Rule 5.1 does not restrict this Court’s ability to address the remainder of Microsoft’s motion.

January 27, 2025

Respectfully Submitted,

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